

REMARKS

In response to the Office Action, there is presented an amendment and remarks which should place this application in condition for allowance or, in the alternative, in better condition for appeal. Accordingly the Examiner is respectfully requested to enter the above amendment to the claims and to reconsider the rejections as pointed out below.

Claim 152, which inadvertently provided for dependence upon a cancelled claim, has been amended to correct this defect by referring to only presently pending claims. Thus the objection to claim 152 has been overcome by the above amendment to said claim.

Reissue Application

The rejection of the claims under the recapture rule is respectfully traversed for the following reasons:

a) The precedents *Pannu v Storz Instruments, Inc*, *Hester Industries, Inc. v Stein, Inc*, *In re Clement and Ball Corp. v United States* are not controlling in this application.

b) Broadened claims are allowable herein in view of:

i) The earliest effective filing date of the application is within the 2 year rule, i.e. November 7, 1997, and

ii) New claims in the nature of genus claims not previously entered in the parent patent are now pending and are under the controlling precedent of *In re Doyle*, 293, F3d 1355, 63 U.S.P.Q. 2d 1161 (Fed. Cir. 2002).

It is apparent from the remarks of the Examiner with respect to the rejection of the claims under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject

matter and further in the absence of any rebuttal comments to the controlling precedents of In re Michael P. Doyle 293 F3d 1355; 63 U.S.P.Q. 2d 1161 (Fed. Cir. 2002) hereinafter referred to as “Doyle” and the more recent decision in Medtronic Inc. v. Guidant Corp. 80 USPQ 2d 1558 (Fed. Cir. 2006), hereinafter referred to as “Medtronic”. These cases were cited by Applicant’s attorney and it is deemed that further explanation of the present claims and their relationship to these precedents are in order.

First, there is no issue of broadening of the claims to regain scope given up by means of amendment or argument over the prior art because the present claims were never presented in the prosecution of the issued patent. What is now in this application is a different **embodiment** of the invention disclosed but never before claimed in the prior prosecution history of the parent patent. That is to say, the currently presented claims are to a different invention than was claimed in the parent patent. There were never presented any claims for the novel additive package in the parent patent although the inventors knew and were in possession of such invention upon the filing of the application that matured into the parent patent. As was pointed out earlier in the file of this application, such appreciation and possession of the presently claimed embodiment was stated in the application at Col. 3, lines 23 and 24 wherein it is stated that the fluid compositions of the invention contain “a novel combination of additives” (emphasis added). However, due to a mistake, without deceptive intent, that embodiment of the disclosed invention was never claimed. Such novel additive package is shown in the specification and by way of supplemental declarations submitted in the file history of this reissue application to show that the claimed additive package improved the properties of

phosphate ester hydraulic fluids of more kinds than those containing only the isoalkyl C₄ and C₅ substituents of the phosphate ester in the hydraulic fluid.

In summary, the error sought to be corrected by this reissue application is not to claim a phosphate ester hydraulic fluid previously narrowed by amendment during the prosecution of the parent patent but rather to claim an **embodiment** disclosed but never before claimed during the prosecution of the parent patent.

In view of the above, there is no need to undergo the analysis of *In re Clement*, 131 F3d at 1468-70, 45 USPQ 2d at 1164-65. In fact such analysis is misplaced when considering a new embodiment of an invention never before claimed for the reason that the claimed embodiment was never presented, rejected or amended in the prosecution of the parent patent.

At page 6 of the above noted Office Action, the Examiner states “the functional fluid of the amended reissue application does not require a specific phosphate ester based fluid, which is claimed more broadly, since it does not include the limitation to just the preferred phosphate esters.” The error of the Examiner is shown by such statement in that there is no limitation contained in the present claims directed to a “phosphate ester”. As pointed out in the last response, the correct claim construction of the pending claims requires a conclusion that a mere recitation of use in the preamble is not a limitation with respect to the claimed composition.

In essence, the recapture rule prevents a patentee from regaining through reissue, subject matter that was surrendered during prosecution of the original patent in an effort to obtain allowance of the original claims. In certain instances even that rule is not always followed by the courts. See *Medtronic* noted above. In that case there were two

embodiments of a heart pacemaker disclosed and claimed in the original application. In one embodiment, the invention was to a method and apparatus for treating ventricular asynchrony by having heart ventricles contract simultaneously in a “conditional embodiment” wherein there were placed sensing electrodes in each ventricle. In the other embodiment termed “unconditional embodiment”, there was placed only one sensing electrode in one ventricle. While there were claims that incorporated both embodiments in the original application, the Examiner narrowed such claims to include only the “conditional embodiment” during a telephonic interview with Applicant’s attorney. The changes made by the Examiner were termed “minor wording changes” to put them in condition for allowance. The reissue application was submitted to claim the “unconditional embodiment”. Medtronic filed a declaratory judgment action to declare the reissue patent invalid for reclaiming matter surrendered during prosecution of the original patent. Both the trial court and the CAFC decided that the reissue patent was valid because the Applicant did not reduce the scope of the claims intentionally or by argument over any prior art. It is clear in this case that the reissue claims with only one electrode is more broad than the claims of the patent that required two electrodes.

The invention in Doyle is a method of using chiral catalysts to catalyze enantioselectively particular classes of chemical reactions. Most reactions that produce these types of compounds do not produce only one type but rather a mixture of stereoisomers of a particular compound, called a racemic mixture. A category of reactions known as enantioselective reactions, however will produce either one enantiomer or a mixture that is enriched in a desired enantiomer. The application was subject to a nine-way restriction requirement and one of the nine categories was selected. Claims to the

elected invention were allowed. Approximately one month after the two-year limit on broadening reissues, Doyle filed a request for reissue of the patent and gave as his reason for reissue that the patent was partially defective because the claims were more narrow than the disclosure and the prior art. The newly requested claims were broader in order to cover the use of the defined catalysts to enantioselectively catalyze reactions with a prochiral compound. In other words, he sought to cover the reaction of his catalysts with a genus of prochiral molecules, not just insertion of a carbene fragment. As in the present application, all of the claims in Doyle's reissue application are new claims, not amendments to issued claims. These claims were rejected on the grounds that the reissue declaration failed to specify an error correctable by reissue under the "Orita Doctrine", recapture and double patenting. After agreeing to file a terminal disclaimer if claims were allowed, he appealed the first two rejections. The court then stated that "The statute was remedial in nature, based on fundamental principles of equity and fairness, and should be construed liberally." This was followed by a statement that section 251 was not a panacea to cure every mistake which might be committed by an Applicant or his attorney. (the Orita Doctrine).

In Doyle, the court did not agree that the Orita Doctrine applied to the reissue application because the new claims were neither identical nor substantially similar to the nonelected claims. The new claims were genus claims, neither identical nor substantially similar to the nonelected claims. The Court reasoned that Orita did not apply because the Applicant never asserted the reissue claims or anything similar to them in the original application and also never agreed to prosecute the reissue claims in a divisional

application. Further, the claims in the reissue application could have and should have been presented in the original application because they were linking claims.

It is important to understand that in Doyle, the Court recognized that the new claims were broader than the issued claims and therefore the “issued claims are ‘wholly or partly inoperative or invalid....by reason of the patentee claiming....less than he had a right to claim in the patent.’”

As noted earlier in the record of this reissue application, Applicant’s attorney has termed the new claims in this reissue application “genus claims” that are not limited by the particular type of phosphate ester fluid. Similar to the Doyle case above, the Applicant did not present these genus claims during the prosecution of the parent patent by mistake. Similar to Doyle, the genus claims are broader than the claims of the issued patent but that is because they are a different embodiment. Similar to Doyle, the mistake of the Applicant or his attorney rendered the patent “wholly or partly inoperative or invalid....by reason of the patentee claiming....less than he had a right to claim in the patent.” The only difference between the present facts and those of Doyle is the absence of a restriction requirement. Such difference is inconsequential to the appropriate law in this application because the court in Doyle dismissed the rejection based upon the Orita Doctrine. Simply stated, as in Doyle, Applicant did not claim all that he had a right to claim in the original patent and now relies on the reissue statute to remedy the error made without deceptive intent. As previously noted in the prior response by Applicant in this application, quoting the Court in Doyle, this fact situation is “precisely the reason” the reissue statute was enacted.

In view of the controlling precedent of Doyle and the same fact situation as in Doyle presented herein, it is respectfully submitted that the three step test for recapture is not applicable and should not be required herein. Accordingly, the Examiner is respectfully requested to withdraw the rejection of the claims under the "recapture rule".

Claim Rejection under 35 USC § 103

It is assumed that the claims rejected herein as being unpatentable over MacKinnon et al (4,206,067) in view of Smith (3,679,587) are claims 131-152 as noted in the previous Office Action.

The remarks in the previous response to this rejection are incorporated herein by reference. Further, the stark contrast between the prior art and the present invention is the disclosure of Smith. Guided by the present disclosure of Deetman at Col. 9, the amount of anti-erosion additive of Deetman is greatly different than the amount of surfactant of Smith. The preferred amount in Deetman is 500ppm in the hydraulic fluid system whereas the Smith disclosure calls for from 0.1 percent to about 5 percent based upon the amount of phosphate ester (.001 parts to 5 parts per 100 parts of phosphate ester). Thus, the selection of various parts of the invention from the prior art, without recognizing the amount of the part cannot properly support a rejection under 35 USC 103. Accordingly the Examiner is respectfully requested to withdraw the rejection based upon the combination of MacKinnon et al in view of Smith.

The rejection of claims 131-152 under 35 U.S.C. 103(a) as being unpatentable over MacKinnon (4,206,067) in view of Smith (3,679,587) and further in view of Great Britain (1,370,728) and French (2,120,127) is respectfully traversed.

The remarks in the previous response to this rejection are incorporated herein by reference. In addition, it is observed that this rejection is based upon four (4) references combined to piece together the invention. While the Examiner rightly justifies finding prior art based upon the claimed subject matter, the compositions in each of the additive packages of each of the references are widely different in total. Certain parts of each additive package of the references may refer to some part of the additive package claimed herein. However, the picking and choosing of the parts now easily done by reference to the Applicant's claims was not available to the Applicants when the invention was made. That is, there are more aspects of the prior art not chosen than chosen and there is no guidance in the art as to which parts of the prior art to combine as now combined in the present claims.

In response to Applicant's argument, the Examiner relies upon KSR Int'l Co. v Teleflex Inc., 550 U.S.____, 2007 WL1237837, at *12(2007) hereinafter referred to as "the KSR decision". This decision was handed down April 30, 2007. The problem with using this authority is noted in the Examiner's response by the quote "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results" (emphasis added). As was noted earlier in the record of this application, there is evidence that the combination of the presently claimed additive package has produced much more than "predictable results". This result was so surprising that it escaped the attention of Applicant's attorney during the prosecution of

the parent application. As noted in the last communication with the office, the evidence submitted by the inventor shows that the claimed additive package not only improved the properties of the novel fluids containing particular iso- C₄ and C₅ alkyl group but also those phosphate esters containing different alkyl groups. It is settled law that not all members of a class need be tested in order to provide evidence of unexpected results in each class tested. Accordingly, the rejection based upon lack of commensurate scope of the evidence is without merit.

Although the KSR decision of April 30, 2007 introduced the concept of “common sense” into the determination of whether an invention is or is not “obvious”, the courts have not abandoned the criteria of *In re Papesch*, noted in the last response. An example of that is provided in the decision also noted in the last response by reference to the decision in *In re Sullivan* decided August 29, 2007, some months after the KSR decision had been handed down. The KSR decision gave no guidance as to whose “common sense” was to be applied, that of an Examiner having knowledge of the invention or that of the inventor prior to making the invention. As noted above, with all of the references before the inventor, there is nothing that guided the path to the present invention except arduous work and testing to determine the combination of additives that would not only improve the novel fluids having specific iso- C₄ and C₅ alkyl groups but also the fluids of the prior art. Thus, under the law as announced in *Papesch*, it is again submitted that the prior art cited by the Examiner does not support a valid rejection under 35 U.S.C. 103(a) and the rejection on the basis of *MacKinnon* (4,206,067) in view of *Smith* (3,679,587) and further in view of *Great Britain* (1,370,728) and *French* (2,120,127) is respectfully requested to be withdrawn.

If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions regarding the present amendment, it is respectfully requested that the Examiner please telephone Applicant's undersigned attorney in this regard.

Respectfully submitted,

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